



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/604,636	06/27/2000	Marco A. DeMello	MSFT-0189/154576.1	3999

7590

04/28/2004

Peter M Ullman  
Woodcock Washburn Kurtz Mackiewicz  
& Norris LLP  
One Liberty Place 46th Floor  
Philadelphia, PA 19103

EXAMINER

ZHEN, LI B

ART UNIT

PAPER NUMBER

2126

DATE MAILED: 04/28/2004

8

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/604,636

Applicant(s)

DEMELLO ET AL.

Examiner

Li B. Zhen

Art Unit

2126

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 February 2004.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-51 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-51 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 1 – 51 are pending in the application.

#### ***Information Disclosure Statement***

2. Applicant requested that the Examiner consider references submitted with a Supplemental Information Disclosure Statement filed on January 14, 2003. Examiner was unable to locate the Supplemental IDS in the application file. The only Information Disclosure Statements on file were filed on May 17, 2001 and September 19, 2000. Examiner respectfully request that the applicant resubmit the Supplemental Information Disclosure Statement filed on January 14, 2003 along with the certificate of mailing date so that the references cited in that IDS can be considered.

#### ***Drawings***

3. Drawings filed on June 27, 2000 are objected to by the draftsman under 37 CFR 1.84 or 1.152 for the reasons indicated on Form PTO-948 included as an attachment to this paper. Corrected drawings are required.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1, 5 – 10, 15, 18, 19, 43 and 46 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,021,492 to May [cited in previous office action].**

6. As to claim 1, May teaches detecting the installation of predetermined software [initiates request to verify software versions on the remote computer; col. 7, line 43 – col. 8, line 30];

detecting an activation status [activation status is places as inactive] of the predetermined software [user is queried as to whether additional use is requested; col. 11, lines 54 – 67]; and

if the activation status indicates that the predetermined software is not activated [a request activation, re-activation or change of parameters in software is made; col. 9, line 57 – col. 10, line 23], launching an activation feature to activate the predetermined software [an agreement on terms is reached, in a step 163, a user of the computer system is notified...by an activation message or an activation page being sent to the computing system...in a step 165 a coupon is activated in accordance with the terms agreed upon in step 162, Fig. 10; col. 10, lines 1 - 23].

7. As to claim 10, this is a method claim that corresponds to product claim 1; note the rejection to claim 1 above, which also meets this method claim. As to the additional limitations, May teaches a remote computer device [remote computer; col. 7, lines 43 – 60].

8. As to claim 5, May teaches launching the predetermined software [once the software is activated within the computing system, use of the software is metered according to the agreed upon style and parameters; col. 2, lines 5 – 43].

9. As to claims 6 and 7, May teaches the predetermined software enables the viewing of a first plurality of titles regardless of the activation status of the predetermined software [if it is detected that the user has not completed an access level the user is allowed continued access to the software; col. 11, lines 33 – 55], and the predetermined software enables the viewing of a second plurality of titles only if the predetermined software is activated [if it is detected that the user has completed an access level, a check is made to determine whether the user is authorized to use the next level...if it is determined that the user is authorized to use the next level, the user is allowed continued access to the software; col. 11, lines 33 – 55].

10. As to claims 8 and 19, May teaches providing an activation certificate [a coupon is activated in accordance with the terms agreed upon; col. 10, lines 1 – 25].

11. As to claims 9 and 18, May teaches providing data which identifies a user who activates the predetermined software [MIS system updates its data base information on the customer; col. 8, lines 12 – 29].

Art Unit: 2126

12. As to claim 15, see the rejection to claim 1 above.

13. As to claims 43 and 46, May teaches the software can exist in either an activated state [coupon is activated in step 165; col. 11, lines 33 – 45] or a non-activated state [activation status is placed as inactive; col. 11, lines 54 – 64], the software is enabled to perform a first set of actions [current level] when the software is in the non-activated [coupon allowing usage of the software is expired] state [If it is determined in step 204 that the user is not authorized to use the next level, in step 176, the coupon allowing usage of the software is expired; col. 11, lines 33 – 55], and the software is enabled to perform the first set of actions [current level] and a second set of actions [next level] when the software is in the activated [authorized to use next level] state [If it is detected in a step 203 that the user has completed an access level, in a step 204, a check is made to determine whether the user is authorized to use the next level. If it is determined in step 204 that the user is authorized to use the next level, the user is allowed continued access to the software and returns to step 202; col. 11, lines 33 – 55].

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. **Claims 2 – 4, 11 – 14, 16, 17, and 20 – 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over May in view of U.S. Patent No. 6,298,446 to Schreiber [cited in the previous office action].**

16. As to claim 2, May teaches communications over the internet and the world wide web [col. 3, lines 38 – 52] but does not specify a client scripting language.

However, Schreiber teaches protection of digital images transmitted over a network [col. 6, lines 18 – 26] and a client scripting language [CGI script instructions or Visual Basic instructions, col. 14, lines 55 – 62; col. 16, lines 1 – 15].

17. It would have been obvious to a person of ordinary skilled in the art at the time of the invention to apply the teaching of client scripting language as taught by Schreiber to the invention of May because scripting languages provide quick and easy development, cycle-compiling and linking is not necessary.

18. As to claim 3, May as modified teaches the client scripting language is selected from the group consisting of: Java [Java Applets; col. 6, lines 25 – 43 of Schreiber] and VISUAL BASIC [CGI script instructions or Visual Basic instructions, col. 14, lines 55 – 62; col. 16, lines 1 – 15 of Schreiber].

19. As to claim 4, May as modified teaches the one or more scripting functions enable use of the computer-executable instructions with at least two different browsing programs [for the Netscape Communicator web browser, such additional software may

be a plug-in or a Java applet... for the Internet Explorer web browser, such additional software may be an Active-X control or a Java applet; col. 7, lines 1 – 19 of Schreiber].

20. As to claim 11, this is rejected for the same reasons as claim 2 above.

21. As to claim 12, May as modified teaches the script functions are interpretable by a web browser using a scripting language [opens a URL for an active server page in his web browser; col. 16, line 63 - col. 17, line 17 of Schreiber].

22. As to claim 13, this is rejected for the same reasons as claim 3 above.

23. As to claim 14, May as modified teaches the first and second instructions are transmitted in an HTTP web page [in response to a user selecting a URL with a CGI script or such other script, client computer 106 issues an HTTP request to server computer 100 that includes instructions for generating a web page; col. 16, lines 1 – 15 of Schreiber].

24. As to claim 16, May as modified teaches the first and second instructions are implemented by way of a COM object [Active-X control] on the first computing device [for the Internet Explorer web browser, such additional software may be an Active-X control or a Java applet; col. 7, lines 1 – 19 of Schreiber].



25. As to claim 17, May as modified teaches the first and second instructions are implemented as a browser plug-in on the first computing device [for the Netscape Communicator web browser, such additional software may be a plug-in or a Java applet; col. 7, lines 1 – 19 of Schreiber].

26. As to claim 20, May as modified teaches the software comprises a digital content rendering application [additional software is used to decode the encrypted image data, and render it for display on a video monitor; col. 7, lines 1 – 19 of Schreiber].

27. As to claim 21, May as modified teaches [col. 9, lines 9 – 33 of Schreiber] the first party is a consumer of digital content [serves web pages 104 to a plurality of client computers 106 over the Internet], and the second party is a distributor of digital [web pages 104 typically contain references to images] content [server computer 100 typically includes web server software 102 that serves web pages 104, Fig. 1].

28. As to claim 22, May as modified teaches a computer-readable medium [a hard disk 42, Fig. 3; col. 4, lines 35 – 45 of May].

29. As to claims 23 – 25, May as modified teaches an electronic distribution infrastructure [copyright protection of digital images for use within a distributed server-client computing environment; col. 9, lines 8 – 33 of Schreiber], the method comprising:

providing, to a first party [client computers 106; col. 9, lines 9 – 33 of Schreiber], at least one of the following: a first set of computer-executable instructions for use with first browsing software [for the Netscape Communicator web browser, such additional software may be a plug-in or a Java applet; col. 7, lines 1 – 19 of Schreiber]; and a second set of computer-executable instructions for use with second browsing software [for the Internet Explorer web browser, such additional software may be an Active-X control or a Java applet; col. 7, lines 1 – 19 of Schreiber], and

providing, to a second party [server computer 100; col. 9, lines 9 – 33 of Schreiber], a browser-executable script which uses either the first or the second sets of instructions [CGI script instructions or Visual Basic instructions, col. 14, lines 55 – 62; col. 16, lines 1 – 15 of Schreiber], according to whether the script is executed under the first or the second browsing software [software such as a Netscape plug-in or an Internet Explorer Active-X control is used to modify operating system function; col. 19, lines 1 - 10 of Schreiber]. As to detecting installation of the software; detecting activation of the software; activate the software; providing information related to the identity of the first party; and providing an activation certificate associated with the first party, see the rejection to claims 1, 8 and 9 above.

30. As to claim 26, this is rejected for the same reasons as claim 21 above.

31. As to claim 27, May as modified teaches the second party distributes information supplied by a third party [copyright protection of digital images for use within a distributed server-client computing environment; col. 9, lines 8 – 33 of Schreiber].

32. As to claim 28, May as modified teaches the information comprises an electronic book [copyright protection of other forms of multi-media referenced in web pages as well, such as audio files, video files and slide shows; col. 32, line 60 – col. 33, line 5 of Schreiber].

33. As to claims 29 and 30, May as modified teaches the multimedia files comprise one or more of the following: music, video, animations, and pictures [copyright protection of other forms of multi-media referenced in web pages as well, such as audio files, video files and slide shows; col. 32, line 60 – col. 33, line 5 of Schreiber].

34. As to claims 31 and 32, these are rejected for the same reasons as claims 2 and 3 above.

35. As to claim 33, May as modified teaches a COM object for use with a MICROSOFT INTERNET EXPLORER browser [for the Internet Explorer web browser, such additional software may be an Active-X control or a Java applet; col. 7, lines 1 – 19 of Schreiber], and wherein the second set of computer-executable instructions comprises a plug-in for use with a NETSCAPE NAVIGATOR browser [for the Netscape

Art Unit: 2126

Communicator web browser, such additional software may be a plug-in or a Java applet; col. 7, lines 1 – 19 of Schreiber].

36. As to claims 34 and 35, this is rejected for the same reasons as claims 14 and 22 above.

37. As to claims 36 – 38, May as modified teaches including a script of instructions in a web page and transmitting the web page to the remote computing device [in response to a user selecting a URL with a CGI script or such other script, client computer 106 issues an HTTP request to server computer 100 that includes instructions for generating a web page; col. 16, lines 1 – 15 of Schreiber]. As to detecting the installation of software; detecting the activation of the software; activate the software; providing information related to the identity of a user; and providing an activation certificate associated with the user, see the rejection to claims 1, 8 and 9 above.

38. As to claims 39 and 40, these are rejected for the same reasons as claims 2 and 3 above.

39. As to claim 41, May as modified teaches detect whether the script is executing on first browsing software or second browsing software and perform either a first action or a second action according to whether the script is executing on the first or the second browsing software [software such as a Netscape plug-in or an Internet Explorer Active-X

control is used to modify operating system function; col. 19, lines 1 – 10 and col. 7, lines 1 – 19 of Schreiber].

40. As to claim 42, this is rejected for the same reasons as claim 22 above.

**41. Claims 44, 45 and 47 – 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over May in view of U.S. Patent NO. 6,006,332 to Rabne.**

42. As to claim 44, May teaches the software is associated with a first persona [user] when the software is in the activated state [If it is detected in a step 203 that the user has completed an access level, in a step 204, a check is made to determine whether the user is authorized to use the next level. If it is determined in step 204 that the user is authorized to use the next level, the user is allowed continued access to the software and returns to step 202; col. 11, lines 33 – 55], and wherein the second set of actions comprises actions that the first persona is permitted to perform [If it is determined in step 204 that the user is authorized to use the next level, the user is allowed continued access to the software and returns to step 202; col. 11, lines 33 – 55]. May does not teach preventing a second person from performing a second set of actions.

43. However, Rabne teaches a digital rights management system [col. 3, lines 50 – 60], providing individual rights for each user [intellectual property existing in RM system A are provided to a user based on the rights of the user registered with the RM system; col. 18, lines 20 – 34], and denying another user permission [intellectual property

existing in RM system A are provided to a user based on the rights of the user registered with the RM system; col. 18, lines 1 – 36].

44. It would have been obvious to a person of ordinary skilled in the art at the time of the invention to apply the teaching of providing individual access right for each user and preventing a second user from performing a second set of actions as taught by Rabne to the invention of May because this prevents unauthorized uses of this digital media throughout the time it is resident on workstation and provides content to a user based on that information and the license agreement information which was previously stored in the databases [col. 18, lines 10 – 35 of Rabne].

45. As to claim 45, May as modified teaches the second set of actions comprises the rendering of digital content items [Examiner notes that using the next level would require rendering of digital contents] that are licensed for use by the first persona [If it is detected in a step 203 that the user has completed an access level, in a step 204, a check is made to determine whether the user is authorized to use the next level. If it is determined in step 204 that the user is authorized to use the next level, the user is allowed continued access to the software and returns to step 202; col. 11, lines 33 – 55 of May] and are not licensed for use by the second persona [intellectual property existing in RM system A are provided to a user based on the rights of the user registered with the RM system; col. 18, lines 1 – 36 of Rabne].

Art Unit: 2126

46. As to claims 47 – 48, these are method claims that correspond to product claims 44 – 45; note the rejections to claims 44 – 45 above, which also meet these product claims.

47. As to claims 49 and 50, May as modified teaches the software can exist in either an activated state [coupon is activated in step 165; col. 11, lines 33 – 45 of May] or a non-activated state [activation status is placed as inactive; col. 11, lines 54 – 64 of May], wherein the software is enabled to render a first set of content items [current level] when the software is in the non-activated [coupon allowing usage of the software is expired] state [If it is determined in step 204 that the user is not authorized to use the next level, in step 176, the coupon allowing usage of the software is expired; col. 11, lines 33 – 55 of May], wherein the software is enabled to render the first set of content items [current level] and a second set of content items [next level] when the software is in the activated [authorized to use next level] state [If it is detected in a step 203 that the user has completed an access level, in a step 204, a check is made to determine whether the user is authorized to use the next level. If it is determined in step 204 that the user is authorized to use the next level, the user is allowed continued access to the software and returns to step 202; col. 11, lines 33 – 55 of May], the second set of content items being licensed to the first party [If it is determined in step 204 that the user is authorized to use the next level; col. 11, lines 33 – 55 of May], there being a second party to which the second set of content items is not licensed [intellectual property existing in RM system A are provided to a user based on the rights of the user registered with the RM

Art Unit: 2126

system; col. 18, lines 1 – 36 of Rabne], the second set of content items being cryptographically bound to the activation certificate associated with the first party [an alternative external authentication, public key certificates--such as X509, Public Key Cryptographic Standard (PKCS) number 11 smartcards or cryptographic tokens--can also be used to allow a user access to the RM system; col. 22, lines 25 – 39 of Rabne].

48. As to claim 51, May as modified teaches software is initially installed in the non-activated state [use of remote management to initialize software metering in accordance with a preferred embodiment of the present invention. In a step 161, a request activation, re-activation or change of parameters in software is made; col. 9, line 65 – col. 10, line 12 of May], and the software cannot be returned to the non-activated state after the software has been placed in the activated state [all of the required updates have been made, the newly created holding's data is permanently stored into an RM library; col. 8, lines 47 – 55 of Rabne].

### ***Response to Arguments***

49. Applicant's arguments filed February 20, 2004 have been fully considered but they are not persuasive.

50. Applicant argues, "...it is clear that May does not teach the methods recited in claims 1 and 10, and that the 'activation status' recited in the claims have a different meaning from the 'activation status' mentioned in May" [p. 14, lines 14 – 17; p. 16, lines



Art Unit: 2126

6 – 16]. Examiner respectfully disagrees because the “activation status” as brought out in the claims is clearly taught by May. The “activation status” as claimed indicates whether a software is activated or not [claim 1, line 5; claim 10, lines 6 – 7] and the “activation status” of May also indicates whether a software is activated or not [If in step 212, the user indicates no additional use is desired, in a step 213, the work is saved for later access by the user or by the remote management system and the software is exited. In a step 214, the activation status is placed as inactive, which will prevent further access to the software; col. 11, lines 54 – 64 of May]. Therefore, May teaches ‘activation status’ of the current application as brought out in the independent claims.

### ***Conclusion***

51. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 2126

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

52. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Li B. Zhen whose telephone number is (703) 305-3406.

The examiner can normally be reached on Mon - Fri, 8:30am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (703) 305-9678. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Li B. Zhen  
Examiner  
Art Unit 2126

lbz  
April 23, 2004

  
**MENG-AL T. AN**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2100**